

**Application No. :** 09/706,965  
**Amdt. Date :** July 31, 2003  
**Reply To Office Action Of :** April 2, 2003

### **REMARKS**

By way of summary, Claims 1 and 12-15 are pending in this application.

The Office Action rejected Claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 5,372,135, issued to Mendelson et al., (the Mendelson patent). Although the Applicants respectfully traverse each of the § 102(e) rejections and the characterization of the Mendelson patent as it pertains to the claimed invention, in order to expedite prosecution and allowance of this application, the Applicants submit that the Mendelson patent is not prior art to the present application under 35 U.S.C. §§ 102(a) or 102(e). Rather, the Applicants assert that they invented the subject matter of independent Claim 1 and dependent Claim 12 prior to the effective date of the Mendelson patent. To support the foregoing assertion, the Applicants submit herewith the enclosed Declaration of one of the joint inventors, Mohamed K. Diab, setting forth facts and evidence that the Applicants conceived of the subject matter of Claims 1 and 12 on or before the earliest effective filing date of the Mendelson patent, and then diligently reduced the subject matter to practice. Moreover, the Applicants submit that the Mendelson patent does not claim the same patentable subject matter as recited in pending Claim 1 and 12.

#### **The Effective or Critical Date of the Mendelson Patent May be as Early as December 31, 1991**

From the face of the Mendelson Patent, it appears that the Mendelson patent may be able to sustain an effective or critical filing of December 31, 1991. For example, the patent includes a claim for a priority benefit to U.S. Patent Application Serial No. 815,469, filed December 31, 1991, which eventually was abandoned.

#### **The Applicants Conceived of the Claimed Invention on or Prior to December 31, 1991**

The enclosed Declaration establishes that the Applicants conceived the of the claimed subject matter prior to the critical date of December 31, 1991. Moreover, from a time just prior to the critical date, until a reduction to practice, the Applicants diligently and continuously experimented with and refined their transfer functions. Therefore, the

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Applicants respectfully submit that the Mendelson patent is not prior art to the present invention.

**The Mendelson Patent Claims Are Directed Toward Obtaining Differential Absorption Spectrums, Which is Different Than The Subject Matter Of Independent Claim 1 or Dependent Claim 12**

The Applicants also assert that the independent claims in the Mendelson patent are directed towards methods and an apparatus for obtaining a differential absorption spectrum. In contrast, the present application recites an independent claim directed toward a system for non-invasively monitoring concentrations of blood constituents where the system comprises, among other things, an active pulse inducement device which causes a periodic change in a volume of blood in the fleshy medium.

Based on the foregoing, the Applicants respectfully assert that the Mendelson patent is not prior art under 35 U.S.C. §§ 102(a) or 102(e). 37 C.F.R. § 1.131; M.P.E.P. §§ 715 and 2136.05 (providing that 35 U.S.C. §§ 102(a) or 102(e) rejections can be overcome by antedating the filing date of the U.S. patent reference through the submission of an affidavit or declaration). Accordingly, the Applicants respectfully request withdrawal of the rejections of Claims 1 and 12 based on the same.

Claims 13-15 which depend from independent Claim 1, are believed to be patentable for the same reasons articulated above with respect to independent Claim 1, and because of the additional features recited therein.

**Request For Telephone Interview**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. The Applicants' attorney can be reached at (949) 721-2946 or at the number listed below.

Application No. : 09/706,965  
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In addition, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

July 31, 2003

By:

John M. Grover

Registration No. 42,610

Attorney of Record

Customer No. 20,995

(949) 760-0404

Enclosure

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